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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,964	01/16/2007	Florence Henry	C 2925 PCT/US	8591

23657 7590 05/21/2008
COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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05/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,964	Applicant(s) HENRY ET AL.	
	Examiner Christopher R. Tate	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006 (preliminary amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0207</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-20 are presented for examination on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 16-19, 22, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 22, and 29 are rendered vague and indefinite by the final step recited therein - i.e., "removing the solvent from the solution, to recover the extract" for two reasons. Firstly, it is unclear how one would remove the solvent from the solution since the solvent is apparently defining the solution (i.e., they are not two separate entities). Secondly, it is unclear by this phrase as to what portion actually constitutes the "extract" - e.g., is it the extract solvent solution itself or the leaf material remaining after the solvent solution has been removed therefrom?

Claims 16-19 are rendered vague and indefinite by the phrase "wherein the cosmetic treatment comprises ..." (line 1 of each) because the recitation thereafter in each of these claims are drawn to functional effects provided by (not comprised of) the applied extract. Accordingly, for clarity, it is suggested that the term "comprises" within the cited phrase be omitted and replaced with --provides--. [Also, as a formal matter - in claims 16 and 17, the comma should be removed after the term "wherein" within the cited phrase.]

Claims 27-29 are rendered vague and indefinite by the phrase "A method of preparing a cosmetic composition of claim" (line 1 of each) because it is unclear by this phrase if these claims are attempting to define some type of alternative embodiment or if they are in fact drawn to the same preparatory method defined by claims 20, 27, and 28, respectively. Further, this phrase is also unclear because, as drafted, it appears to indicate that claims 20, 27, and 28 are drawn to a product (i.e., "a cosmetic composition of claim") instead of to a method, *per se*. It is suggested that these respective claims be amended accordingly, including by changing the initial phrasing to read as follows:

--27. The method of preparing a cosmetic composition according to claim 20, whereby said mixing comprises ...-- or similar phraseology.

--28. The method of preparing a cosmetic composition according to claim 27, whereby said mixing comprises ...-- or similar phraseology.

--29. The method of preparing a cosmetic composition according to claim 28, whereby the extract is obtained by a method comprising: ... -- or similar phraseology.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also rejected under USC 112, second paragraph for the reasons set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 14, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Withcl (1994 - reference cited by Applicants in the IDS submitted 2/20/2007).

A composition comprising an extract of *Castanea sativa* leaves and cosmetic auxiliaries and/or additives is claimed, as is a method of preparing such an extract via extracting the *Castanea sativa* leaves with water and/or alcohol to form an extract solution and removing the solvent from the solution to recover the extract, as well as preparing a cosmetic composition via mixing an extract of *Castanea sativa* leaves with a cosmetic auxiliary/additive composition.

Withcl teaches preparing an extract composition from the leaves of *Castanea sativa* via pouring boiling water over finely cut leaves, letting it stand for a short time, passing the water extract solution through a strainer, adding cold water thereto (please note that water reads upon a cosmetically-acceptable auxiliary and additive), which is then passed thru another strainer (to remove the extract solvent from the leaf material). In addition, this reference teaches that such *Castanea sativa* leaf extract preparations have been incorporated into various prior art pharmaceutical compositions which would also inherently comprise such auxiliaries and/or additives therein (see page 133, third column under the headings *Making the tea* and *Phytomedicines*).

Therefore, the reference is deemed to anticipate the instant claims above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1655

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyrot et al. (FR 2 850 273 - full English translation of this document also enclosed).

Peyrot et al. teach topically-applied cosmetic compositions comprising an extract of *Castanea sativa*, preferably from the buds thereof. In addition, Peyrot et al. beneficially teach that such a cosmetic extract preparation may also be obtained from other parts of the *Castanea sativa* tree including from the leaves thereof. Peyrot et al. also beneficially disclose the addition of one or more auxiliaries/additives to their extract preparation (such as various ones from those instantly claimed) as well as incorporating 0.1-10 weight percent of the extract within such cosmetic compositions. Peyrot et al. further disclose preparing such an extract via extracting the plant material (e.g., buds, leaves, wood, or bark) with a solvent such as water and/or an alcohol (e.g., ethanol, methanol, etc), and removing the solids therefrom such as by filtering the extract solvent one or more times to obtain a concentrated extract thereof. Peyrot et al. also disclose topically applying such a cosmetic composition to a person's skin for various therapeutic cosmetic purposes including to stimulate the synthesis of essential components of the extracellular matrix (e.g., elastin, collagen, and hyaluronic acid) by dermal cells, and for the cytoprotection of the skin (see entire document including full English translation thereof).

Art Unit: 1655

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare a cosmetic composition comprising an extract from the leaves of *Castanea sativa* (via the instantly claimed preparatory steps) as the active ingredient therein (including within the instantly claimed weight percentage range), as well as to topically apply such a cosmetic composition to a person's skin, based upon the overall beneficial teachings provided by the cited reference, as discussed above. Please note that the topical application of such a *Castanea sativa* leaf extract preparation to a person's skin would intrinsically provide the functional effects instantly claimed. The adjustment of particular conventional working conditions (e.g., using one or more commonly-employed cosmetic auxiliaries/additives therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

Applicant cannot rely upon the foreign priority papers to overcome the rejection immediately above because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 11-14, 20-23, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withcl (1994 - reference cited by Applicants in the IDS submitted 2/20/2007).

Withcl beneficially teaches preparing an extract composition from the leaves of *Castanea sativa* via pouring boiling water over finely cut leaves, letting it stand for a short time, passing the water extract solution through a strainer, adding cold water thereto (please note that water reads upon a cosmetically-acceptable auxiliary and additive), which is then passed thru another strainer (to remove the extract solvent from the leaf material). In addition, this reference teaches that such *Castanea sativa* leaf extract preparations have been incorporated into various prior art pharmaceutical compositions which would also inherently comprise such auxiliaries and/or additives therein (see page 133, third column under the headings ***Making the tea*** and ***Phytomedicines***).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare a therapeutic composition comprising an aqueous extract of *Castanea sativa* leaves as the active ingredient therein, based upon the beneficial teachings provided by the cited reference. The adjustment of particular conventional working conditions (e.g., determining an appropriate concentration of such a leaf extract and/or adding commonly employed auxiliaries/additives - many of which would also read upon cosmetic auxiliaries/additives - thereto) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Thus, the invention as a whole is *prima facie* obvious over the reference, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/
Primary Examiner, Art Unit 1655